REMARKS

STATUS OF THE CLAIMS

Claims 1 and 3-49 are pending as shown in the paper mailed on October 25, 2004.

REJECTIONS WITHDRAWN

Applicants note that the obviousness-type double patenting rejections have not been reiterated and, therefore, are considered withdrawn.

35 U.S.C. § 102(E)

Claims 27, 30-33, 35, 37, 40-43, 45 and 46 were rejected under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Patent No. 6,458,127 (hereinafter "Truckai"). Office Action, pages 3-4. Truckai is alleged to teach all the limitations of these claims, including a device that is "adapted to be deployed into the body cavity while retaining the three-dimensional shape during the deployment procedure." Office Action, page 3.

As described throughout the specification, the embodiments of claims 27, 30-33, 35, 37, 40-43, 45 and 46 all relate to devices that are formed into a three-dimensional configuration and deployed into a body cavity in that same three-dimensional configuration (*see, e.g.,* page 6, lines 20-23, emphasis added):

> Further, unlike known vaso-occlusive elements that assume a secondary configuration (*e.g.,* three-dimensional configuration) **after** extrusion from the deployment catheter, the injection-molded elements described herein typically are formed into their three-dimensional configurations **prior to** deployment and are **delivered and deployed** in these secondary configurations.

In other words, the overall three-dimensional configuration of the devices of claims 27, 30-33, 35, 37, 40-43, 45 and 46 is the same prior to, during and after deployment.

In stark contrast, Truckai discloses a device whose overall three-dimensional configuration changes dramatically after deployment. As shown in Figure 6B and described at col. 8, lines 33-67 of Truckai, the polymeric occluder (12) of this reference is extruded from the catheter into the malformation such that the three-dimensional configuration of the occluder (12) changes from linear prior to and during deployment to the much different space-filling shape after deployment.

Therefore, because Truckai does not describe or demonstrate a device which is formed, delivered and ultimately deployed in the same three-dimensional configuration, this reference cannot anticipate pending claims 27, 30-33, 35, 37, 40-43, 45 and 46 and withdrawal of this rejection is requested.

35 U.S.C. § 103

Claims 1, 3-7, 9, 11, 14-17, 19, 24, 26, 28, 29 and 47-49 were rejected under 35 U.S.C. § 103(a) as allegedly anticipated by Truckai in view of U.S. Patent No. 6,332,884 (hereinafter "Cooper"). Office Action, pages 5-7. In addition, claims 27-32, 40-42, 45, 47 and 48 were again rejected as allegedly obvious over Cooper in view of U.S. Patent No. 6,656,173 (hereinafter "Palermo"). Office Action, pages 7-9.

In support of this rejection, Truckai is cited as above. Cooper and Palermo are cited as in the Office Action mailed July, 2004.

With respect to the rejection based on Truckai, Applicants note that this reference is itself entirely silent as to injection molded devices, as set forth in claims 1, 3-7, 9, 11, 14-17, 19, 24, 26. In addition, for the reasons noted above, Truckai does not teach or suggest devices that do not change three-dimensional configuration after deployment into the target site, as set forth in claims 28, 29 and 47-49.

Cooper does not supply the elements missing from Truckai (or from Palermo). For the reasons of record, Applicants submit that there is no motivation to combine Cooper with either Truckai or Palermo as suggested by the Office, because Cooper relates to a different field of endeavor, namely implants rather than vaso-occlusive devices. In response to the previous argument that a *prima facie* case of obviousness cannot be established because Cooper does not teach vaso-occlusive devices or methods of occlusion as claimed, the Examiner states (*see,* page 10 of Office Action, emphasis in original):

> Applicant has argued that Cooper does not teach vaso-occlusive elements since "vascular implants" (as taught by Cooper) is not a vaso-occlusive device. The examiner notes that Cooper does teach an occluder since it is considered a vascular implant. In fact, Applicant admits this to be true since he discloses that "vaso-occlusion devices are surgical implements or implants that are placed within the vasculature of the human body ..." See the specification lines 16-17. Accordingly, Cooper as modified by Palermo remains applicable to the above noted claims.

This incomplete quotation mischaracterizes Applicant's description of vaso-occlusive devices. As a whole, the quoted sentence completes the definition of vaso-occlusive devices to include only those implants that result in the formation of an embolus (page 1, lines 16-20):

> For example, vaso-occlusion devices are surgical implements or implants that are placed within the vasculature of the human body, typically via a catheter, either to block the flow of blood through a vessel making up the portion of the vasculature through the formation of an embolus or to form such an embolus within an aneurysm stemming from the vessel.

The specification makes it plain the vaso-occlusive devices are not any surgical implement that is implanted into the vasculature, but, rather, only include those devices that form an embolus. The fact remains that Cooper teaches nothing about vaso-occlusive elements or methods of making vaso-occlusive elements. The "vascular implants" and "preformed defect fillers" disclosed in this document are not vaso-occlusive devices as claimed. Accordingly, a skilled artisan working in the field of vaso-occlusive devices would likely be unaware of Cooper and certainly would not have been motivated to combine anything about this disclosure with references in the field of vaso-occlusive devices.

Applicants again note that unlike the claimed devices, Cooper also requires that the matrix material deform upon heating and that the device assumes a different configuration after deployment **as it cools**. *See, e.g.,* Abstract of Cooper. Claim 27 and claims dependent therefrom require the opposite -- the device is configured and deployed in the same three-dimensional configuration.

Thus, there is no motivation to combine Cooper with Truckai or Palermo and no combination of these references that would render pending claims obvious. Accordingly, withdrawal of this rejection is in order.

CONCLUSION

For the reasons discussed above, Applicant submits that the claims are in condition for allowance and request early notification to that effect. If the Examiner has any further issues or wishes to discuss any of the foregoing, she is invited to contact Applicant's undersigned attorney at the telephone number listed below.

Respectfully submitted,

Date: February 22, 2005

By: _____
Dahna S. Pasternak
Attorney for Applicant
Registration No. 41,411

ROBINS & PASTERNAK LLP
1731 Embarcadero Road
Suite 230
Palo Alto, CA 94303
Tel. (650) 493-3400
Fax. (650) 493-3440